REMARKS

Claims 36, 38-48, 50-59. 61-65, and 67-73 are pending in the present application. Claims 36, 38-39, 46, 48, 50-51, 57, 59, and 61-62 were amended to maintain antecedent basis and to further clarify that which was previously claimed. In addition, Claims 37, 49, 60 and 66 have been canceled without prejudice or disclaimer of the claimed subject matter. Support for the amendments to the Claims can be found in at least paragraphs [0014] - [0015], [0131] and [0143] of the specification. No new matter has been added. Favorable reconsideration and allowance of the present application are respectfully requested.

Co-Pending Applications

To fully comply with 37 CFR §1.56, Applicant and Applicant's Attorney hereby disclose the existence of the following related and commonly owned patent and patent application: U.S. Patent Application Serial No. 10/263,566, filed October 3, 2002, entitled SERVICE AUTHORIZER and U.S. Patent No. 7,233,655 B2, issued June 19, 2007, entitled MULTI-MODAL CALLBACK. The specification has been amended accordingly.

In addition, in an abundance of caution, Applicant and Applicant's Attorney hereby disclose the existence of six commonly owned patents and co-pending patent applications, some of which are incorporated by reference in the present application. Specifically, U.S. Patent Application Serial No. 10/131,898, filed April 25, 2002, entitled NATURAL LANGUAGE PROCESSING FOR A LOCATION-BASED SERVICES SYSTEM; U.S. Patent Application Serial No. 10/133,536, filed April 26, 2002, entitled ADVERTISING CAMPAIGN BUSINESS LISTING MANAGEMENT FOR A LOCATION-BASED SERVICES SYSTEM; U.S. Patent

No. 6,848,542 B2, issued February 1, 2005, entitled METHOD FOR PASSIVE MINING OF USAGE INFORMATION IN A LOCATION-BASED SERVICES SYSTEM; U.S. Patent Application Serial No. 10/133,118, filed April 26, 2002, entitled ROUTING CALL FAILURES IN A LOCATION-BASED SERVICES SYSTEM; U.S. Patent Application Serial No. 10/134,405, entitled TRACKING PURCHASES IN A LOCATION-BASED SERVICES SYSTEM; U.S. Patent No. 6,944,447 B2, issued September 13, 2005, entitled LOCATION-BASED SERVICES; and U.S. Patent Application Serial No. 11/007,761, filed December 8, 2004, entitled PASSIVE MINING OF USAGE INFORMATION IN A LOCATION-BASED SERVICES SYSTEM.

The Examiner is strongly encouraged to review all of the above-identified patents and applications to confirm the subject matter is patentably distinct from the present application. In Applicant's attorney's opinion, the claims of the above-identified patents and applications are patentably distinct. However, the Examiner is specifically encouraged to carefully review the office actions, and the basis of the rejections of the following claims due to the possibility of similarities of at least some of the limitations included in at least the recited claims of the following patents and pending applications:

> U.S. Application Serial No. 10/264,219 – Claims 17, 23, and 46.
>
> U.S. Patent No. 7,233,655 B2 – Claims 1, 9, 17, and 26.
>
> U.S. Patent Application Serial No. 10/131,898 – Claims 1, 10, and 17.
>
> U.S. Patent Application Serial No. 10/133,118 – Claims 29, 36, 47, and 57.

Information Disclosure Statement

An Information Disclosure Statement was filed on November 13, 2006, together with a

PTO Form 1449 listing the references cited therein. We have received an initialed copy of the

PTO Form 1449. However, U.S. Patent No. 7,020,251 was not indicated as having been

considered by the Examiner. Applicant respectfully requests a copy of the PTO Form 1449

indicating that U.S. Patent No. 7,020,251 has been considered.

Claim rejections pursuant to 35 U.S.C. § 103(a)

Claims 36-41, 43-52, and 54-56 were rejected pursuant to 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent Publication No. 20020055351A1 to Elsey et al. (hereinafter

referred to as "Elsey"), in view of U.S. Patent No. 6,449,344 to Goldfinger et al. (hereinafter

referred to as "Goldfinger"), and further in view of U.S. Patent No. 6,546,005 to Berkley et al.

(hereinafter referred to as "Berkley"). Also, Claims 42 and 53 were rejected pursuant to 35

U.S.C. § 103(a) as being unpatentable over Elsey, in view of Goldfinger, in view of Berkley, and

further in view of U.S. Patent No. 6,345,245 to Sugiyama et al. (hereinafter referred to as

"Sugiyama"). In view of the amendments to the claims and the following remarks, Applicant

respectfully traverses these rejections since a *prima facie* case of obviousness in view of the cited

references can no longer be supported.

Claims 36, 38-47

Amended Claim 36 describes a method that includes generating a response for transmittal

to the wireless terminal only when the reply is indicative of permission to proceed with provision

of the requested information record to the wireless terminal, the response including only information from the information record that is identified by a user of the subscriber terminal as permissible to send to the wireless terminal. None of the cited references teach or suggest that a response includes only information from an information record that is identified by a user of the subscriber terminal as permissible to send to the wireless terminal as described in Claim 36. Claim 36 also describes receiving, from a wireless terminal, a contact information request with an information assistance application located on an information assistance server, wherein the contact information request is a request for an information record associated with a subscriber terminal that is other than the wireless terminal, and determining a contact preference for how to contact the subscriber terminal about the received contact information request with the information assistance application.

Elsey describes a system that employs information call centers accessible by subscribers. (para 39) Each subscriber has folders that have contacts, appointments, etc. that can be manually accessed by communication with a live operator working in the information call center, following receipt of an incoming call from a subscriber. (para 39, 47-48 and 57) Elsey further describes that the live operator manually performs not only user login, but also accesses the subscriber's folders to provide requested information. (para 58) Elsey further describes that a user access rights to folders on the system are determined by the user's login information such that a user may have full access to some folders, and read only access to other folders. Thus, the system of Elsey is limited to interaction of a single subscriber with information stored in a plurality of folders via communication with a live operator.

On page 3 of the office action mailed May 21, 2007, it was asserted that Elsey "discloses generating and transmitting an authorization request to the subscriber, called party terminal for

privacy protection." However, what Elsey actually describes is "privacy protection previously imposed by the owner or administrator of the folder." (para 64) Elsey is clearly not generating or transmitting an authorization request since Elsey describes that an administrator is able to pre-designate certain information in a folder as private, and thus make such pre-designated information inaccessible to read only users. (para 64) Clearly, Elsey is describing only interaction between a subscriber and folders. No other subscriber in Elsey's system is involved in the activities of a subscriber in accessing data in one or more of Elsey's folders via an operator. Thus, contrary to assertions on page 3 of the office action mailed May 21, 2007, Elsey does not teach or suggest generating an authorization request to request permission from the subscriber terminal to provide the information record of the subscriber terminal to the wireless terminal, or transmitting the authorization request to the subscriber terminal in accordance with a determined contact preference as described in Claim 36.

On page 3 of the office action, it is further indicated that "Elsey does not explicitly teach as claimed i.e., providing requested information of the subscriber terminal in response to the authorization information received from the subscriber terminal." To bridge this gap, Goldfinger was applied to modify Elsey. However, Goldfinger describes a communication system used to indicate when other users are connected to the system. (Col. 4 lines 60-65) Goldfinger also describes that a user connects to the system and generates a list of sought users. (Col. 6 lines 3-5) The system checks if the sought users are currently connected and if so provides indication to the requesting user that the sought users are connected to the system. (Col. 6 lines 13-23) Goldfinger also describes a list of users that request to be asked for authorization prior to revealing to a requesting user that such users are connected to the system. (Col. 6 lines 5-12) In addition, Goldfinger describes that such sought users receive a request for authorization, and

either authorize or decline to allow their information to be provided to the requesting users. (Col. 6 lines 51-61)

Applicant respectfully traverses the asserted modification of Elsey's folder system with Goldfinger's communication system because the addition of Goldfinger's authorization feature changes the principal of operation of Elsey's system and because the addition of Goldfinger renders Elsey's system unsatisfactory for it intended purpose. If a proposed modification would change the principal of operation of the prior art invention, or would make the prior art invention being modified unsatisfactory for its intended purpose, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01(V and VI)

In this case, Elsey describes a system in which subscribers interact with folders for which they have proper authorization. Elsey is not concerned with nor teaches or suggests any form or authorization to provide information other than settings in folders that are maintained by users with administrator capabilities and viewed by users with read only capabilities. Thus, addition of Goldfingers authorization list to Elsey's folder scheme would render useless and inoperable Elsey's privacy protections imposed by an owner or administrator by settings in Elsey's folders, thus changing the principal of operation of Elsey's folders system. On page 3 of the office action, it was asserted that the combination of Elsey and Goldfinger would be obvious to one of skill in the art to "to share private information of a subscriber terminal based on an authorization response received from the subscriber terminal." However, Applicant respectfully submits that Elsey describes that authorization is provided by pre-defined owner settings within Elsey's folders, not by contacting a subscriber terminal for an authorization response following receipt of a request for contact information.

In addition, Elsey does not involve a determination of whether a sought user is currently connected, nor creation of a list of sought users. To the contrary, Elsey simply describes that the subscriber is provided access to all folders for which the subscriber is authorized to access upon successful login. (para 60 of Elsey) Thus, subscriber's in Elsey's system have no concern for who is connected to the system, nor with creating a list of sought users since all the folders (and permitted information therein) are pre-defined and readily available to the subscriber in Elsey's system upon successful login. Moreover, Elsey describes a system in which a user interacts only with folders, not with other users. Thus, a fundamental operational principal of Elsey's system would be changed by the addition of Goldfinger's authorization list and ability to authorize or decline providing an indication that a user is connected.

On pages 3 and 4 of the office action mailed May 21, 2007, it was further indicated that neither Elsey nor Goldfinger teach of suggest "determining a contact preference." To bridge this gap, Berkley was applied as a further modification to Elsey. Berkley describes an active user registry (AUR) that provides a brokering process between a calling party and a party to be called. The cited portions of Berkley describe that the AUR determines, based on the communication method of the calling party, what is the best way to connect the calling party to the party to be called based on communication options provided by the party to be called. Here again, the modification of Elsey to include the AUR of Berkley not only changes the principal of operation of Elsey's system, but also renders Elsey's system unsatisfactory for its intended purpose since Elsey is clearly not directed to a system to broker two way communication between subscribers, but rather describes a system to provide information from folders to a single inquiring user via an operator. Moreover, Elsey's system is not concerned with nor in anyway operational to provide

two way communication between subscribers, but rather is simply to allow a single subscriber to interact with folders containing information.

Claim 39 describes a response that comprises a multi-modal message that includes both a voice-based response and a text-based response during a single interaction. On page 5 of the office action mailed May 21, 2007 it was asserted that Elsey teaches such limitations, however, Elsey actually teaches away by describing use of various reminder notifications as alternatives ("utilize one method of delivery over another"), which is clearly not a multi-modal message that includes both a voice-based response and a text-based response as described in Claim 39. On page 5 of the office action response mailed May 21, 2007, it was asserted that Elsey rendered obvious the voice recognition module of Claim 41. Applicant respectfully traverses this assertion because Elsey very clearly describes that Elsey's VRU "is employed to play the constantly repeated parts of an operator's speech." (para 51) Clearly, interpreting a contact information request as described in Claim 41, and playing back pre-recorded speech as described by Elsey are entirely different. Contrary to the assertions on page 6 of the office action mailed February 20, 2007, generation of a multi-modal response, as described in Claim 46 is also not taught or suggested.

Claims 48, 50-58

Amended Claim 48 describes a code segment that generates a response to the wireless terminal that includes at least a portion of an information record associated with the subscriber terminal when permission is granted, the at least a portion of the information record including from the record information only information specified by a user of the subscriber terminal as acceptable to be provided to the wireless terminal. None of the cited references either alone or in

combination teach or suggest including from the record information only information specified

by a user of the subscriber terminal as acceptable to be provided to the wireless terminal.

Further, Applicant respectfully traverses the asserted combination of Elsey with Goldfinger and

Berkely for the previously discussed reasons.

Claim 51 describes that the response comprises a multi-modal message that includes both

a voice-based response and a text-based response. None of the cited references, either alone or

in combination describe such a multi-modal message. Claim 52 describes a code segment

configured to interpret the contact information request with voice recognition. None of the cited

references described interpretation of a contact information request with voice recognition. As

previously discussed, the pre-recorded voice unit of Elsey is clearly not capable of interpret

contact information. Claim 55 describes a code segment that performs voice print analysis to

determine an identity associated with a requestor. Contrary to the assertions on page 5 of the

office action mailed May 21, 2007, Elsey's VRU is simply a pre-recorded speech playback unit,

and thus cannot possibly determine an identity associated with a requestor by performing voice

print analysis as described in Claim 55.

Claims 57 describes that the code segment that generates an authorization request

includes a code segment that determines an identity of a requestor, and Claim 58 describes a

code segment that includes the identity of the requestor with the authorization request. None of

the cited references teach or suggest determination of an identity of a requestor, nor inclusion of

such a determined identity in an authorization request. In fact, the office action mailed May 21,

2007 does not assert that any of the cited references meet the limitations described in Claims 57

and 58, but rather simply disregards these limitations completely. Accordingly, it is respectfully

requested that the rejection of Claims 57 and 58 be withdrawn as improper. (See MPEP 707 and

37 CFR §1.104(b) and 37 CFR §1.104(c))

Claims 59, 61-65

Amended Claim 59 describes an information assistance application further configured to

generate a response for the wireless terminal that includes only that information from the

information item that is specified by a user of the subscriber terminal, the response generated

only when the reply indicates the information item is to be provided. None of the cited reference

either alone or in combination teach or suggest generation of a response for the wireless terminal

that includes only that information from the information item that is specified by a user of the

subscriber terminal. In addition, Applicant respectfully traverses the proposed modification of

Elsey by Goldfinger and Berkley since such modifications render Elsey unsuitable for its

intended purpose and change the principal of operation of Elsey as previously discussed.

Claim 62 describes that the information assistance application is configured to include a

multi-modal response that includes both a voice-based response and a text-based response.

Contrary to the assertion on page 5 of the office action mailed May 21, 2007, Elsey does not

teach or suggest such a multi-modal response. In addition, Claim 63 describes generation of an

authorization request to include a multi-modal message that includes a voice-based request and a

text-based request, which neither Goldfinger nor Elsey teach or suggest.

Claim 64 describes inclusion with an authorization request a requestor information item

that identifies the requestor to the subscriber terminal. None of the cited references teach or

suggest such limitations. In fact, the office action mailed May 21, 2007 does not assert that any

of the cited references meet the limitations described in Claim 64, but rather simply disregards
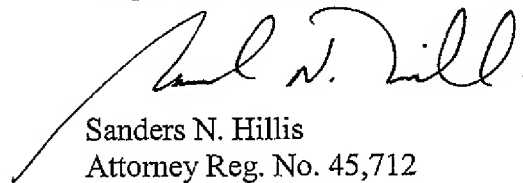
the limitations of Claim 64 completely. Accordingly, it is respectfully requested that the

rejection of Claim 64 be withdrawn as improper. (See MPEP 707 and 37 CFR §1.104(b) and 37

CFR §1.104(c))

For at least the foregoing reasons, independent Claims 36, 48 and 59, and the claims

dependent therefrom are patentable over the cited combination of references. In addition, new

Claims 67-73 are also not taught or suggested by any of the cited references either alone or in

combination. Since the presently pending claims of this application are allowable over the cited

references, Applicant respectfully requests the issuance of a Notice of Allowance for this

application. Should the Examiner deem a telephone conference to be beneficial in expediting

allowance/examination of this application, the Examiner is invited to call the undersigned

attorney at the telephone number listed below.

Respectfully submitted,

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